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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/638,654	08/14/2000	Roger William Gutwein	7718M	9656

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EXAMINER
WEIER, ANTHONY J

ART UNIT	PAPER NUMBER
1761	13

DATE MAILED: 05/06/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/638,654	Applicant(s) GUTWEIN ET AL	
	Examiner Anthony Weier	Art Unit 1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on 07 April 2003 .

2a)☐ This action is FINAL. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-7 and 9-34 is/are pending in the application.

4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 9-34 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 12 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

1. Claims 9-34 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In particular, the original specification does not appear to support the ranges for brew solids and Delta Standard Yield now set forth in claim 8. More specifically, the instant specification discloses a Delat Standard Yield of less than 8%. As for the brew solids, various amounts are set forth in the examples that are less than 30%, but no upper limit of 30% is set forth. The Examiner notes the reference to "30%" on page 5, line 7, but this is in reference to the brew solid results of prior art products. There is, however, no reference to specifically "less than about 30%" for the the present invention.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-13 and 18-34 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 9-198570.

JP 9-198570 discloses a process wherein a coffee extract is prepared in a vending machine, stored for a period of time (e.g. 30 minutes), and diluted within a range as called for in the instant claims (e.g. 1:10 extract to water), wherein the strength of the coffee may be adjusted based on the preference of the customer using the vending machine (e.g. page 9 of translation; examples). It is considered inherent that

JP 9-198570 includes particular brew solids values that fall within the ranges called for in the instant claims.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 9-13 and 18-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 9-198570.

If it is shown that JP 9-198570 does not inherently set forth brew solids and Delta Standard Yield that fall within the ranges called for in the instant claims, it should be noted that JP 9-198570 discloses employing various concentrations ratios of extract water. Absent a showing of unexpected results, it would have been well within the purview of one having ordinary skill in the art at the time of the invention to have varied said concentrations (as well as temperature employed, e.g. 80 C or higher) to arrive at an extract having a certain brew solids strength and Delta Standard Yield as a matter of preference to the manufacturer with regard to costs involved, amount of dilution required later, etc.

4. Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 9-198570 (as set forth in paragraph 1 above).

It should be noted that JP 9-198570 discloses the use of different types of coffee from different types of raw material[1]. JP 9-198570 is silent regarding the use of coffee that has been roasted. However, it is notoriously well known to roast coffee to be used for extraction, and, absent a showing of unexpected results, it would have been obvious to one having ordinary skill in the art at the time of the invention to have included same as a matter of preference.

5. Applicant's arguments with respect to the instant claims have been considered but are moot in view of the new ground(s) of rejection[2].

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Weier whose telephone number is 703-308-3846. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 703-308-3959. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3602 for regular communications and 703-305-3602 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

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[1] Athough JP 9-198570 discloses the use of "raw material" in describing the coffee to be extracted, it is considered to be "raw" in the sense that the coffee has not been extracted. It should be noted that even though JP 9-198570 discloses the use of coffee which has clearly been ground (i.e. descriptions of spooning coffee material in examples), the coffee is referred to as being "raw".

[2] New claim 34 still contains the limitations that were at issue in cancelled claim 8.

Anthony Weier
Primary Examiner
Art Unit 1761

Anthony Weier
May 2, 2003